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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/372,416      | 08/11/1999  | JONATHAN DORFMAN     | EWG-087             | 1373             |

7590 01/12/2004

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EXAMINER

HUYNH, THU V

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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DATE MAILED: 01/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/372,416

Applicant(s)

DORFMAN, JONATHAN

Examiner

Thu V Huynh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. This action is responsive to communications: amendment filed on 10/23/2003 to application filed on 08/11/1999.
2. Claims 2, 3, 5-6 and 10 are amended.
3. Claims 1-15 are pending in the case. Claims 1, 4, 5, 6, and 10 are independent claims.
4. The objection of claim 10 as having typographical error has been withdrawn in view of the amendment.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1, 3-13, and 15 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Landsman et al., US 6,516,338 B1 priority filed 01/26/1999, in view of HotScripts, [http://hotscripts.com/JavaScript/Scripts\\_and\\_Programs/Banner\\_Rotation/](http://hotscripts.com/JavaScript/Scripts_and_Programs/Banner_Rotation/), <http://javascript.internet.com/messages/banner-ads.html>, and <http://www.hotscripts.com/Detailed/105.html>, updated 06/25/1999, pages 1-6.

**Regarding independent claim 1**, Landsman teaches the steps of:

- a web browser which can retrieve files, interpret JavaScript, and display web pages (Landsman, abstract; and col.11, lines 38-58; a web browser which can retrieve advertisement, JavaScript files; executing the JavaScript file; and displaying web page through the web browser);
- a first internet server which includes a web page that includes an advertising macro tag (Landsman, col.11, lines 38-41; and fig.1B, box 13; web site (contents) server 13 which includes a web page that includes an advertising tag);
- a second internet server which includes a JavaScript file (Landsman, col.11, lines 38-41; col.16, lines 53-57; and fig. 1B, box 15; JavaScript file is stored on agent server (distribution server));
- an advertisement server which provides advertisements in response to links from said browser (Landsman, abstract; and fig.1B, box 20 and communication 18)
- said macro tag including a link to said second internet server (Landsman, col.11, lines 38-41; and fig.1B, box 45; advertising tag references to the JavaScript file “loaded.js” which is stored on the distribute server “http://unicast\_ad\_server.com”);

Landsman teaches executing the JavaScript file to instantiate an agent implement Java applet at client browser to download advertising files from a third-party advertising server; and subsequently displaying and playing advertising files through the browser in response to a user click-stream (Landsman, col.9, line 62 – col.10, line 9). However, Landsman does not explicitly disclose the JavaScript file including a link to said advertisement server.

HotScripts teaches JavaScript file includes links to other servers to retrieve an advertisement banner gif files (HotScripts, page 5, lines 16-18) whereby said JavaScript file is executed and advertisement is displayed each time said web browser access said web page (HotScripts, page 3, lines 2-3).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined HotScripts and Landsman to provide advertisement using JavaScript file which is stored on the server, since JavaScript is a language that was well known used to extend the capabilities of HTML.

**Regarding dependent claim 3**, which is dependent on claim 1, Landsman and HotScripts teach the limitations of claim 1 as explained above. Landsman teaches wherein said web page contain HTML code (Landsman, abstract; col.11, lines 38-58; and fig.2A).

**Regarding independent claim 4**, Landsman teaches the steps of:

- including on a web page a macro tag with a link to a file on a command server, said file including JavaScript commands, whereby advertisements called for by said macro tag are displayed (Landsman, col.11, lines 38-41; col.16, lines 53-57; and fig.1B, boxes 13 and 15; including on a web page a advertising tag with a link to a JavaScript file which is stored on agent/distribution server).

Landsman teaches executing the JavaScript file to instantiate an agent implement Java applet at client browser to download advertising files from a third-party advertising server; and subsequently displaying and playing advertising files through the browser in response to a user

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click-stream (Landsman, col.9, line 62 – col.10, line 9). However, Landsman does not explicitly disclose JavaScript commands which link to said advertisement server, whereby advertisements called for by said macro tag are displayed.

HotScripts teaches JavaScript file includes command to link to other servers to retrieve advertisement banner gif files (HotScripts, page 5, lines 16-18) whereby said JavaScript file is executed and an advertisement is displayed each time said web browser access said web page (HotScripts, page 3, lines 2-3).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined HotScripts and Landsman to provide advertisement using JavaScript file which is stored on the server, since JavaScript is a language that was well known used to extend the capabilities of HTML.

**Regarding independent claim 5**, Landsman teaches the steps of:

- a command server which includes a command file (Landsman, col.11, lines 38-41; col.16, lines 53-57; and fig. 1B, box 15; JavaScript file (command file) is stored on agent/distribution server (command server)); and
- web pages including macro tags which direct browsers to retrieve said command file on said command server (Landsman, col.11, lines 38-41; and fig.1B, boxes 13 and 45; web site (contents) server 13 which includes web pages including advertising tags to retrieve the JavaScript file stored on distribution server).

Landsman teaches executing the JavaScript file to instantiate an agent implement Java applet at client browser to download advertising files from a third-party advertising server; and

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subsequently displaying and playing advertising files through the browser in response to a user click-stream (Landsman, col.9, line 62 – col.10, line 9). However, Landsman does not explicitly disclose the command file with links to an advertisement server; and browsers are directed to retrieve advertisements from said advertisement server when they access a web page.

HotScripts teaches JavaScript file (command file) includes command to link to other servers to retrieve advertisement banner gif files (HotScripts, page 5, lines 16-18) whereby said JavaScript file is executed, advertisements are retrieved and displayed each time the browser access said web page (HotScripts, page 3, lines 2-3).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined HotScripts and Landsman to provide advertisement using JavaScript file which is stored on the server, since JavaScript is a language that was well known used to extend the capabilities of HTML.

**Regarding independent claim 6**, Landsman teaches a method for displaying an advertisements on a user's computer in response to commands in a macro tag on a web page which is accessed by an internet browser on said user's computer (Landsman, abstract, col.11, lines 38-58; and fig.1B, box 13), said system comprising:

- a first server with a file that contains a series of commands that can be executed by said browser (Landsman, col.11, lines 38-41; col.16, lines 53-57; and fig. 1B, box 15; JavaScript file that contains command is stored on agent/distribution server that can be executed by the browser); and

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- a second server that contains said advertisement (Landsman, abstract; and fig.1B, box 20, advertisement server contains the advertisements); and
- a link to said file in said macro tag (Landsman, col.11, lines 38-41; and fig.1B, box 45; advertising tag references to the JavaScript file “loaded.js” which is stored on the distribute server “http://unicast\_ad\_server.com”).

Landsman teaches executing the JavaScript file to instantiate an agent implement Java applet at client browser to download advertising files from a third-party advertising server; and subsequently displaying and playing advertising files through the browser in response to a user click-stream (Landsman, col.9, line 62 – col.10, line 9). However, Landsman does not explicitly disclose a link to said second server in said file whereby when said macro tag is executed by said browser, said file is retrieved and said link in said file is executed to retrieve said advertisement and to display said advertisement on said user’s computer.

HotScripts teaches JavaScript file includes command to link to other servers to retrieve advertisement banner gif files (HotScripts, page 5, lines 16-18) whereby said JavaScript file is executed, advertisements are retrieved and displayed each time the browser access said web page (HotScripts, page 3, lines 2-3).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined HotScripts and Landsman to provide advertisement using JavaScript file which is stored on the server, since JavaScript is a language that was well known used to extend the capabilities of HTML.



**Regarding dependent claim 7**, which is dependent on claim 6, Landsman and HotScripts teach the limitations of claim 6 as explained above. Landsman teaches wherein said file contains JavaScript commands (Landsman, col.11, lines 38-41; col.16, lines 53-57; and fig. 1B, box 15; JavaScript file that contains command is stored on agent/distribution server that can be executed by the browser).

**Regarding dependent claim 8**, which is dependent on claim 6, Landsman and HotScripts teach the limitations of claim 6 as explained above. Landsman teaches wherein said advertisement is a gif-image or Java applet (Landsman, col.3, lines 52-60 and col.10, lines 1-10).

**Regarding dependent claim 9**, which is dependent on claim 6, Landsman and HotScripts teach the limitations of claim 6 as explained above. Landsman teaches wherein said file contains JavaScript (Landsman, col.11, lines 38-41; col.16, lines 53-57; and fig. 1B, box 15; JavaScript file that contains command is stored on agent/distribution server that can be executed by the browser).

**Regarding independent claim 10**, Landsman teaches the steps of:

- a web page that includes a macro tag with a reference to a file on a first server, whereby said browser links to said file when said web page is processed by said browser (Landsman, abstract, col.11, lines 38-41; and fig.1B, boxes 13 and 45; web site server 13 which includes a web page that includes an advertising tag that

references to the JavaScript file "loaded.js" which is stored on the distribute server "http://unicast\_ad\_server.com"),

Landsman teaches executing the JavaScript file to instantiate an agent implement Java applet at client browser to download advertising files from a third-party advertising server; and subsequently displaying and playing advertising files through the browser in response to a user click-stream (Landsman, col.9, line 62 – col.10, line 9). However, Landsman does not explicitly disclose said file including a link to an advertisement server having an advertisement in a file, whereby said advertisement is displayed by said browser when said file is processed by said browser.

HotScripts teaches JavaScript file includes command to link to other servers to retrieve advertisement banner gif files (HotScripts, page 5, lines 16-18) whereby said JavaScript file is executed, advertisements are retrieved and displayed each time the browser access said web page (HotScripts, page 3, lines 2-3).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined HotScripts and Landsman to provide advertisement using JavaScript file which is stored on the server, since JavaScript is a language that was well known used to extend the capabilities of HTML.

**Regarding dependent claim 11**, which is dependent on claim 10, Landsman and HotScripts teach the limitations of claim 10 as explained above. Landsman teaches wherein said file contains Javascript (Landsman, col.11, lines 38-41; col.16, lines 53-57; and fig. 1B, box 15;

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JavaScript file that contains command is stored on agent/distribution server that can be executed by the browser).

**Regarding dependent claim 12**, which is dependent on claim 10, Landsman and HotScripts teach the limitations of claim 10 as explained above. Landsman teaches wherein said macro tag contains a series of HTML statements (Landsman, fig.2A, box 40).

**Regarding dependent claim 13**, which is dependent on claim 11, Landsman and HotScripts teach the limitations of claim 11 as explained above. Landsman teaches wherein said macro tag contains a series of HTML statements (Landsman, fig.2A, box 40).

**Regarding dependent claim 15**, which is dependent on claim 11, Landsman and HotScripts teach the limitations of claim 11 as explained above. Landsman teaches wherein said system determines the characteristics of said browser and executes instruction compatible with said browser's characteristics to display said advertisement (Landsman, col.12, lines 45-49; and col.21, lines 58-65; displaying advertisements depend on different user computer browsing platforms).

6. **Claims 2 and 14 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Landsman in view of HotScripts as applied to claims 1 and 11 above, and further in view of "HTML 4.0", XP-002191626, revised on 04/24/1998, as supplied by Applicant in IDS filed on 05/29/2002.**

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**Regarding dependent claim 2**, which is dependent on claim 1, Landsman and HotScripts teach the limitations of claim 1 as explained above. Landsman teaches wherein said macro tag has commands to access said advertisement (Landsman, col.18, lines 36-41). However, Landsman does not explicitly teach wherein said macro tag has commands to access said advertisement server *if said web browser does not have the capability of executing JavaScript*.

HTML 4.0 teaches using noscript element to provide alternate content when a user browser does not support script, the user still retrieve data through a link (HTML 4.0, page 244, section 18.3).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined HTML 4.0 into Landsman and HotScripts to provide advertisements to the user browser even the user browser does not have the capability of executing JavaScript, since noscript tag is used to alternate content when a script is not executed and was well known in the art to give a solution when browsers do not support script languages.

**Regarding dependent claim 14**, which is dependent on claim 11, Landsman and HotScripts teach the limitations of claim 11 as explained above. Landsman teaches wherein said macro tag includes a line to said advertisement server (Landsman, col.18, lines 36-41). However, Landsman does not explicitly teach wherein said macro tag includes a line to said advertisement server *which is executed if said browser can not execute Javascript*.

HTML 4.0 teaches using noscript element to provide alternate content when a user browser does not support script, the user still retrieve data through a link (HTML 4.0, page 244, section 18.3).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined HTML 4.0 into Landsman and HotScripts to provide advertisements to the user browser even the user browser does not have the capability of executing JavaScript, since noscript tag is used to alternate content when a script is not executed and was well known in the art to give a solution when browsers do not support script languages.

### ***Response to Arguments***

7. Applicant's arguments filed on 10/23/2003 have been fully considered but they are not persuasive.

Applicants argue that Landsman's teaching teach away from including the reference to the advertisement server in the file referenced in the tag. Applicants further argue that HotScripts fails to teach a macro tag including a link to a second (advertisement) server. Therefore the combined Landsman/HotScripts fails to disclosed what claimed by Applicants.

These are not persuasive. First, Landsman does not teach away from include the reference to the advertisement server in the file referenced in the tag. Landsman in fact teaches a file reference from the first server (as claimed by Applicants) and a reference to the advertisement server in the tag itself. The two components are taught and the suggestion is clear that they are both needed for the system to work. Instead of keeping the reference to the advertisement server in the tag, an ordinary skill in the art would have modified Landsman to

include the same reference in the referenced file downloaded from the first server since this file is needed anyway for the system to run, this is contrary to Applicants' argument that one would not have been motivated to modify the system to use double referencing. HotScripts is referenced to illustrate this obvious modification and to show how it would look like when the reference to the advertisement server is included in the referenced file downloaded from the first server. HotScripts is not referenced to show a macro tag including a link to a second server since this is (already) clearly taught by Landsman's. As pointed out, any ordinary skill in the art would have modified Landsman and HotScript to derive what claimed by Applicants.

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu V Huynh whose telephone number is 703-305-9774. The examiner can normally be reached on Monday, Tuesday and Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached on 703-308-5186. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-9000.

TVH  
January 8, 2004

  
STEPHEN S. HONG  
PRIMARY EXAMINER